REMARKS

I.   Introduction

Claims 18, 23 and 29 are canceled. Claims 17, 19-22, 24-28 and 30-33 are currently pending in the present application. Claims 17, 19, 20, 22, 27-28 and 30-32 have been amended. For at least the reasons set forth below, Applicants submit that the pending claims are in condition for allowance.

II.   Objection to claims 17-26, 28, 32 and 33

The Examiner objected to various grammatical and typographical informalities in the claims. The amendments filed herewith correct those issues. Accordingly, withdrawal of the claim objections is requested.

III   Rejection of Claim 23 under 35 U.S.C. § 112

Claim 23 was rejected under 35 U.S.C. §112, second paragraph, as indefinite. The cancellation of claim 23 renders this rejection moot.

IV   Rejection of Claims 27-29 under 35 U.S.C. § 101

Claims 27 and 28 were rejected as being directed to non-statutory subject matter. Claim 27 has been amended to recites a "non-transitory computer readable storage medium" storing a software system, thereby clearly reciting statutory subject matter. Claim 28 depends on claim 27, and therefore claim 28 also recites statutory subject matter. Claim 29, which was rejected as being directed to non-statutory subject matter, has been canceled.

In view of the foregoing, withdrawal of the 35 U.S.C. §101 rejections is respectfully requested.

V.   Rejection of Claims 17, 18, 20, 21 and 27-33 under 35 U.S.C. § 102

Claims 17, 18, 20, 21 and 27-33 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,872,977 ("Thompson"). In view of cancellation of claims 18 and 29, Applicants note that claims 17, 20, 21 and 27, 28 and 30-33 are pending among the rejected claims.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended claim 17 recites, in relevant part:

automatically generating at least one item of **dependency information describing at least one of**:

whether a particular resource is reserved exclusively for use by the least one functional unit, which comprises a software module in the computer program;

a dependency between abstract configuration data and concrete configuration data;

a sequence in which additional computer scripts, which alter the configuration data stored in the configuration data container, must be executed; and

a relationship between a hardware component and the configuration data stored in the configuration data container;

automatically generating at least one implementation-dependent configuration data file as a function of the configuration data stored in the configuration data container, and **as a function of the at least one item of dependency information**."

Claims 27 and 32 have been amended to recite limitations substantially similar to the above-recited limitations of claim 17.

The Examiner contends that the dependency engine in Thompson includes dependency information. According to col. 4, lines 34-41, a "makefile" is built using a build file and a rules file. Calls from the build file cause a constructor function to build a "dependency engine" in the memory of the computer. The dependency engine includes a list of "makerules" that together have the necessary data to form the platform dependent "makefiles." However, as explained in col. 7, lines 23 and 25, **the dependents listed in each "makerule" are simply dependent files required to form a target file**. Therefore, the **dependencies described in Thompson do not describe** any of the following:

> whether a particular resource is reserved exclusively for use by the least one functional unit, which comprises a software module in the computer program;
>
> a dependency between abstract configuration data and concrete configuration data;
>
> a sequence in which additional computer scripts, which alter the configuration data stored in the configuration data container, must be executed; and
>
> a relationship between a hardware component and the configuration data stored in the configuration data container.

For at least the foregoing reasons, independent claims 17, 27 and 32, as well as their dependent claims 20, 21, 28, 30, 31 and 33, are allowable over Thompson.

VI.   Rejections of Claims 19 and 22-26 under 35 U.S.C. § 103

Claims 19, 22, 23 and 26 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Thompson. Claims 19 and 23 have been canceled, so claims 22 and 26 are pending among the rejected claims.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have

prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

As pointed out above, Thompson fails to teach or suggest all the limitations of parent claim 17. In addition, without passing judgment on the merits of the Examiner's unsupported contention that the subject matter of dependent claims 22 and 26 were "well known at the time of the invention," Applicants note that the Examiner's contention does not remedy the deficiencies of Thompson as applied against parent claim 17. Accordingly, claims 22 and 26 are allowable over Thompson for at least the same reasons discussed above in connection with parent claim 17.

Claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as being rendered obvious over Thompson in view of U.S. Patent Application Pub. No. 2002/0040469 ("Pramberger").

Claims 24 and 25 ultimately depend on claim 17. As pointed out above, Thompson fails to teach or suggest all the limitations of parent claim 17. In addition, Pramberger fails to remedy the deficiencies of Thompson as applied against parent claim 17. Accordingly, dependent claims 24 and 25 are allowable over the combination of Thompson and Pramberger for at least the same reasons as those present in connection with parent claim 17.

Conclusion

Applicants respectfully submit that all pending claims 17, 19-22, 24-28 and 30-33 of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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